

REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action dated May 17, 2006. In that Office Action, claims 6-18, 26 and 27 were examined and stand rejected. Claims 1-5 have been previously cancelled, and claims 19-25 have been previously withdrawn from consideration by the Examiner. More specifically, claims 19-25 are withdrawn from consideration because the Examiner maintains that the claimed invention of claims 19-25 is distinct from the claimed invention of claims 6-18. *See Office Action*, 05/17/06, p. 2. Further, claims 26 and 27 are rejected under 35 U.S.C. § 112; claims 6-13, 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,587,835 to Treyz et al. (hereinafter, "Treyz") in view of "Official Notice;" claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz and "Official Notice" in view of U.S. Patent No. 6,125,385 to Wies et al. (hereinafter, "Wies"); claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and "Official Notice" in view of U.S. Patent No. 6,816,878 to Zimmers et al. (hereinafter, "Zimmers"); and claims 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and "Official Notice" in view of U.S. Patent No. 5,808,907 to Shetty et al. (hereinafter, "Shetty"). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 6, 9, 26 and 27 have been amended, and no claims have been added. The amendments to claims 6 and 9 were made only for the purpose of correcting form. Claims 1-5 remain cancelled, and claims 19-25 have been withdrawn by the Examiner.

Claims 19-25 Withdrawn from Consideration by the Examiner

As noted, claims 19-25 have been withdrawn by the Examiner because the Examiner believes that the claimed invention of claims 19-25 is distinct from the claimed invention of claims 6-18. *See Office Action*, 05/17/06, p. 2. While the Applicant respectfully disagrees that claims 19-25 are directed to an invention distinct from the invention claimed in claims 6-18, the Applicant foregoes additional argument against the Examiner's view in the interest of furthering the prosecution of this application. The Applicant believes that claims 19-25 are patentable and reserves the right to pursue these claims in continuation or divisional application(s).

Claim Rejections – 35 U.S.C. § 112

Claims 26 and 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which the Applicant regards as the invention. The Examiner rejected claims 26 and 27 because there is “insufficient antecedent basis” for the limitations “[t]he computer program product” and “the process.” *Office Action*, 05/17/2006, p. 8 (emphasis added).

While the Applicant respectfully disagrees that there is insufficient antecedent basis for the noted limitations, the Applicant has amended claims 26 and 27 to provide further clarification of the claimed subject matter. In light of these amendments, the Applicant respectfully requests that the Examiner reconsider the 35 U.S.C. § 112, second paragraph, rejections of claims 26 and 27.

Claim Rejections – 35 U.S.C. § 103, Treyz in view of “Official Notice”

Claims 6-13, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of “Official Notice.” The Applicant respectfully traverses the § 103(a) rejections because the Examiner has failed to state a prima facie case of obviousness. A prima facie case of obviousness can be established only when all of the following requirements are satisfied: (1) the reference or combination of references must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation in the references themselves to combine the references; and (3) there must be a reasonable expectation of success. See MPEP §§ 706.02(j) & 2143. Thus, the combination of references cited by the Examiner must teach or suggest every limitation of the claimed invention. *CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); see also MPEP § 2143.03.

The Treyz patent relates to a handheld computing device which primarily provides shopping assistance services. The shopping assistance services contemplated by Treyz include: providing directory information for a mall, handling shopping lists, displaying promotional material in relation to the shopping lists, obtaining information on merchandise in a store, and providing for wireless purchasing of products. In one embodiment of the invention, the user may adjust alert and retention time settings corresponding to various types of messages, *i.e.*,

reminders, notifications, advertisements, proximity messages, local messages, and e-mail. *Treyz*, col. 44; Fig. 69.

With respect to claim 6, *Treyz* fails to teach “storing two or more notification profiles for each of one or more users, wherein each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and wherein each of the notification events is associated with at least one notification type;” “receiving a selection signal to select one notification mode;” and “applying the selected notification mode to the small computer device and wherein the device remains in the selected notification mode until another notification mode is selected and wherein the user is notified of events in accordance with the notification profile associated with the selected notification mode.” Similarly, with respect to claim 9, *Treyz* fails to teach any of the claim elements, such as “a memory unit storing a plurality of notification profiles for each of one or more users, wherein each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and wherein each of the notification events is associated with at least one notification type;” or “a processing unit in response to a profile selected from the plurality of profiles in the memory unit” Further, *Treyz* teaches neither “a first output device notifying the user of a notification event using a first notification type;” nor “a second output device notifying the user of the notification event using a second notification type wherein the second notification type is different from the first notification type.” *See Treyz*, Fig. 69 (providing for a single notification type, *i.e.*, alert response, for each notification event, *i.e.*, message).

Indeed, the Examiner agrees that “*Treyz* do not specifically mention about notification profiles and each notification profile . . . is associated with a predetermined notification mode and wherein within each notification profile . . . are notification events and each of the notification events is associated with a notification type.” *Office Action*, 05/17/2006, p. 11 (emphasis added). Although the Examiner admits that *Treyz* does not teach the required claim limitations of having “each notification profile . . . associated with a predetermined notification mode,” *see, e.g.*, claim 6, among other elements, the Examiner states:

“Official Notice” is taken that both the concept and advantages of providing notification profiles and each notification profile is associated with a predetermined notification mode and wherein within each notification profile are

notification events and each of the notification events is associated with a notification type(s) is well known and expected in the art.

Id. at 12.

The Applicant respectfully traverses the Examiner's finding of "Official Notice." The Examiner has provided no documentary evidence to support the conclusion of "Official Notice." It is well-established that:

Official notice unsupported by documentary evidence *should only be taken* by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

Manual of Patent Examining Procedure (MPEP), § 2144.03 (emphasis added).

Contrary to the Examiner's unsupported contention that it is "well-known and expected in the art" that "each notification profile is associated with a predetermined notification mode," the Applicant respectfully argues that associating notification profiles with notification modes, among other elements, was not well-known and expected in the art, much less "capable of *instant and unquestionable demonstration*" as being well-known. *See id.* For example, while Treyz teaches adjusting alert and retention time settings, or notification types, for the various types of messages, or notification events, *i.e.*, reminders, notifications, advertisements, proximity messages, local messages, and e-mail, Treyz, col. 44, Fig. 69, Treyz fails to teach the concept of a notification system based on "notification profiles" and corresponding "modes." The concept of the present invention's "notification modes" relates to user notifications for different environments, *e.g.*, meeting, outside, or normal modes. Treyz does not provide for "notification profiles" for particular "modes." Indeed, the concept of associating a notification profile with a notification mode is novel and, contrary to the Examiner's argument, was not obvious to one of ordinary skill in the art at the time of invention. There is no prior art or other documentary evidence indicating that the association of a notification profile with a notification mode, among other elements cited by the Examiner, was known, disclosed, or otherwise used in some manner by those of ordinary skill in the art at the time of invention. No prior art references cited by the

Examiner support such a knowledge, disclosure or use, and the Applicant is aware of no such evidence.

Because there is no documentary support for the Examiner's cited "Official Notice," and because the Applicant is aware of no prior art indicating that the concepts alleged by the Examiner as constituting "Official Notice" are in any way common knowledge or well-known in the art, the Applicant respectfully contends that the Examiner's statement of "Official Notice" is erroneous and respectfully requests that the Examiner produce competent and adequate authority for this statement of "Official Notice."

Given that the Applicant's arguments render meaningless the Examiner's reliance on the alleged "Official Notice," no prima facie case of obviousness has been established for claims 6 and 9 because the cited references fail to teach or suggest every limitation of the claimed invention. *See CFMT, Inc.*, 349 F.3d at 1342; *see also* MPEP § 2143.03.

For at least the above reasons, the Applicant respectfully requests reconsideration of the rejections to claims 6 and 9. These claims are believed to be patentable. In addition, claims 7-8, 10-13, and 26-27 are also believed to be patentable as these claims depend from the allowable base claims 6 and 9. Further, the Applicant notes that since the remarks above are believed to render meaningless the Examiner's reliance on the alleged "Official Notice" as a means of rejecting claims 6-13 and 26-27, any remaining arguments supporting the claim rejections are not acquiesced to even though they are not addressed herein.

Claim Rejections – 35 U.S.C. § 103, Treyz and "Official Notice" in view of Wies

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and "Official Notice" in view of Wies. Because claim 14 depends from what the Applicant believes is an allowable base claim 9, *see* discussion *supra*, claim 14 is believed to be patentable over Treyz and "Official Notice" in view of Wies. The Applicant thus respectfully requests reconsideration of the rejection to claim 14 in light of the arguments presented above. Further, the Applicant notes that since the remarks above are believed to render meaningless the Examiner's reliance on the alleged "Official Notice" as a means of rejecting claim 14, any remaining arguments supporting the rejection of claim 14 are not acquiesced to even though they are not addressed herein.

Claim Rejections – 35 U.S.C. § 103, Treyz and “Official Notice” in view of Zimmers

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of Zimmers. Because claim 15 depends from what the Applicant believes is an allowable base claim 9, *see* discussion *supra*, claim 15 is believed to be patentable over Treyz and “Official Notice” in view of Zimmers. The Applicant thus respectfully requests reconsideration of the rejection to claim 15 in light of the arguments presented above. Further, the Applicant notes that since the remarks above are believed to render meaningless the Examiner’s reliance on the alleged “Official Notice” as a means of rejecting claim 15, any remaining arguments supporting the rejection of claim 15 are not acquiesced to even though they are not addressed herein.

Claim Rejections – 35 U.S.C. § 103, Treyz and “Official Notice” in view of Shetty

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of Shetty. Because claims 16-18 depend from what the Applicant believes is an allowable base claim 9, *see* discussion *supra*, claims 16-18 are believed to be patentable over Treyz in view of Shetty. The Applicant thus respectfully requests reconsideration of the rejections to claims 16-18 in light of the arguments presented above. Further, the Applicant notes that since the remarks above are believed to render meaningless the Examiner’s reliance on the alleged “Official Notice” as a means of rejecting claims 16-18, any remaining arguments supporting the claim rejections are not acquiesced to even though they are not addressed herein.

Conclusion

This Amendment and Response fully responds to the Office Action mailed on May 17, 2006. It is recognized that the Office Action may contain arguments and rejections that are not directly addressed by this Amendment and Response due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, the failure, if any, of this Amendment and Response to directly address an argument raised by the Examiner should not be interpreted as reflecting the Applicant’s belief that such argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment and Response, which are not shown, taught, or otherwise suggested by the art of record.

Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

A Petition for a one-month extension of time is enclosed, extending the time for response from August 17, 2006 to September 17, 2006. Please charge Deposit Account No. 13-2725 the amount of \$120 as the requisite fee for a large entity. It is believed that no further fees are due with this Amendment and Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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